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Remarks

Claims 8-16 and 19-39 are pending in the application. Claims 8, 20, 23, 28 and 30 have been amended herein. Favorable reconsideration is respectfully requested in view of the following comments.

I. CLAIM OBJECTIONS

Claim 30 is objected to for depending on canceled claim 29. Claim 30 has been amended herein and now depends from independent claim 23.

Accordingly, withdrawal of the rejection of claim 30 is respectfully requested.

II. REJECTION OF CLAIM 20 UNDER 35 USC §102

Claim 20 stands rejected under 35 USC §102(e) as being anticipated by *Ekelund* (US 5,630,205). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Claim 20 has been amended herein and now recites a portable data terminal that includes a data reader. As discussed in the present application, mobile terminals, such as, for example, portable hand-held scanners or the like, include a data reader, such as a bar code scanner or the like, and are used to track inventory in a warehouse, retail store, etc.

Ekelund relates to compressing and decompressing voice messages in conjunction with storage of the voice message on a mobile phone (see, e.g., Abstract). *Ekelund*, however, fails to teach or suggest a portable data terminal having a data reader, as recited in amended claim 20 and, therefore, does not anticipate claim 20.

Furthermore, for reasons discussed more fully below, it would not have been obvious to one having ordinary skill in the art to modify the mobile phone in *Ekelund* to read and address data in the same manner as the portable data terminal as recited in claim 1.

Accordingly, withdrawal of the rejection of claim 20 is respectfully requested.

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III. REJECTION OF CLAIMS 8-16, 19-39 UNDER 35 USC §103

a. Claims 8-16

Claims 8-16 stand rejected under 35 USC §103(a) as being unpatentable over *Ekelund* in view of *Tsukamoto* (US 5,128,981) and *Gollnick* (US 5,940,771). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Amended claim 8 recites a portable data terminal that includes a *data reader*, wherein first data based on data input via the data reader and second data based on a voice signal are transmitted over the portable data collection network, and at least the second data is transmitted so as to enable a two-way conversation.

As discussed in the present application, portable data terminals conventionally have been used for exchanging data over a portable data collection network. A convenient system for voice communications among each person operating a data collection terminal, however, was not available. Voice communications between operators conventionally was implemented using other means, such as cellular telephones (e.g., the cellular phone system of *Ekelund*), which operate on a substantially different network (e.g., a network optimized for voice communications compared to a network optimized for data exchange).

For example, operators of portable data terminals typically work in a warehouse or retail environment, wherein the work environment can be relatively large. Such operators normally use the portable data terminals to scan products for inventory tracking purposes, price checks, etc. If the operator needed to contact another operator, the options were limited to using a cell phone or using a paging system within the warehouse/store.

A drawback to cellular phone technology is that it requires its own specific communications network.¹ Additionally, cell phones often are inoperable or operate with poor reception within warehouse/stores due to interference and/or shielding effects caused by the building structure. Further, the operator may not have a cell phone, or the cell phone battery may be dead. These drawbacks can make it difficult for one

¹ See page 2, lines 5-20 of the specification

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operator to contact another operator within the facility, and often results in the operator having to physically locate the party he wishes to communicate with.

The invention recited in claim 8 overcomes the above problems by using the portable data collection network, which usually is existing within the facility, for exchanging voice data over the network, thereby enabling a two way voice communications. Further, the operator need not carry a separate communication device, such as a cell phone. Moreover, issues related to reception are virtually eliminated, as the portable data collection network is configured to operate within a warehouse/store environment. As a result, the portable data terminal operator can communicate with other operators, thereby increasing operator productivity. Further, the employer need not provide a separate communicator to the operators or implement a separate communications network, thereby saving the employer considerable costs.

Gollnick relates to a wireless data terminal that can transmit voice mail messages. *Gollnick*, however, fails to teach or suggest that *voice data is transmitted over a portable data collection network so as to enable a two-way conversation*, as recited in claim 8.

Gollnick realized that it would be advantageous to transmit *voice mail* messages between data terminals. Voice mail generally has a low transmission priority (since it need not be transmitted in real time). Further, the amount of data transmitted over the network for a voice mail message typically is less than the amount of data transmitted to sustain a two-way conversation (e.g., a voice mail message is a one-party message that requires no immediate response, thereby minimizing data traffic on the network). *Gollnick*, however, has not been found to teach or suggest that *two-way voice communications* can be conducted over such terminals. Presumably, two-way voice communications between data terminals was thought to be unachievable. Since *Gollnick* teaches the desirability of voice mail features in data terminals, but fails to teach two-way voice communications over the same terminals, *Gollnick* suggests that two-way voice communications are not possible and thus teaches away from two-way voice communications over data terminals.

Tsukamoto and *Ekelund* relate to cellular phone applications (see, e.g., Fig. 1 of *Tsukamoto* and the title of *Ekelund*). As is well known, cellular telephones are wireless versions of conventional "land-line" telephones, and are substantially different devices

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from portable data terminals (e.g., cell phones are not configured to obtain product data and pass the product data over a portable data collection network, while data terminals conventionally are not configured to exchange two way voice communications).

Further, while *Tsukamoto* discloses that the terminal can transmit data, the data in question appears to be related to scheduling (i.e., setting schedules similar to a day planner).² Such features are consistent with a cellular phone, and not with a portable data terminal. Moreover, *Tsukamoto* fails to teach or suggest a data reader used in conjunction with the terminal, which further suggests that the terminal in question is a cellular phone.

As noted above, *Ekelund*, is are directed to cellular or mobile phone technology. More specifically, *Ekelund* explicitly states in the title that it relates to mobile or cellular phones.

Moreover, one would not be motivated to combine *Tsukamoto*, *Ekelund* and *Gollnick* as alleged by the Examiner. As discussed in the present application, cell phones as well as data terminals were well known in the art prior to the invention recited in claim 8. However, noone had thought to implement two-way voice communications, such as had been known in the cell phone art, with portable data terminals, despite a need in the art for such a combination. This is due at least in part to the fact that both systems operate on substantially different networks (e.g., one optimized for voice communications and one optimized for data transfer).

Further, and as has been well established, secondary considerations play a vital role in determining obviousness. One secondary factor is a long felt need in the art for the proposed combination. As noted above, there has been a need in the art for voice and data communications over a portable data collection network. Yet, prior to the present invention, such features were not found in conventional data terminals.

In view of *Gollnick* teaching away from the proposed combination in conjunction with the long felt need for the invention without an actual implementation, it is reasonable to conclude that it would not have been obvious to combine the references as proposed by the Examiner.

² See, e.g., col. 12, ln. 56-col. 15, ln. 54

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Accordingly, withdrawal of the rejection of claim 8 is respectfully requested.

b. Claim 19

Claim 19 stands rejected under 35 USC §103(a) as being unpatentable over *Tsukamoto*, *Gollnick* and *Ekelund* in further view of *Rahnema* (US 5,465,253). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Claim 19 depends from claim 8, which, as discussed above, is not obvious over *Tsukamoto*, *Gollnick* and *Ekelund*. *Rahnema*, which also relates to mobile or cellular phone technology, is cited for the aspect of teaching compressed voice data.

As discussed above, one clearly would not be motivated to combine cellular phone references and portable data terminal references to arrive at the claimed invention. Thus, *Rahnema* (i.e., a cellular phone reference operating on a dedicated cellular phone network) is not combinable with *Gollnick* (a data terminal reference operating on a data network).

Accordingly, withdrawal of the rejection of claim 19 is respectfully requested.

c. Claims 21-22

Claims 21 and 22 stand rejected under 35 USC §103(a) as being unpatentable over *Tsukamoto* and *Ekelund* in view of *Amin* (US 6,006,087). Withdrawal of the rejection is respectfully requested for at least the same reasons.

Claims 21 and 22 depend from claim 20. As discussed above, claim 20 recites a portable data terminal that includes a data reader. *Ekelund*, which relates to cellular phone technology, fails to teach or suggest a portable data reader. *Tsukamoto* and *Amin*, which also relate to cellular phone technology, have not been found to teach or suggest a portable terminal that includes a data reader. Accordingly, *Ekelund*, *Tsukamoto* and *Amin* fail to teach all the features of claim 20.

Since claims 21 and 22 depend from claim 20, they can be distinguished from the cited art for at least the same reasons.

Accordingly, withdrawal of the rejection of claims 21 and 22 is respectfully requested.

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d. Claims 23, 24, 27, 32, 35-39

Claims 23, 24, 27, 32 and 35-39 stand rejected under 35 USC §103(a) as being unpatentable over *Tsukamoto* in view of *Ekelund*. Withdrawal of the rejection is respectfully requested for at least the following reasons.

Amended claim 23 recites a portable data terminal that includes a data reader, wherein data based on data reader and the voice data are transmitted over the portable data collection network, and at least the voice data is transmitted so as to enable a two-way conversation.

As discussed above, neither *Tsukamoto* nor *Ekelund* have been found to teach or suggest a portable data terminal that includes a data reader and exchanges two-way voice communications over a portable data collection network. Thus, *Tsukamoto* and *Ekelund* fail to teach each feature of independent claim 23.

Accordingly, withdrawal of the rejection of claim 23 is respectfully requested.

Claims 24, 27, 32 and 35-39 depend from claim 23 and therefore can be distinguished from the cited art for at least the same reasons.

Accordingly, withdrawal of the rejection of claims 24, 27, 32 and 35-39 is respectfully requested.

e. Claim 26

Claim 26 stands rejected under 35 USC §103(a) *Tsukamoto*, *Ekelund* and *Gollnick*. Withdrawal of the rejection is respectfully requested for at least the following reasons.

As was discussed previously, *Gollnick* relates to data terminals, while *Ekelund* and *Tsukamoto* relate to cellular or mobile telephones. Cellular phones are substantially different devices from a portable data terminal (e.g., cell phones are not configured to obtain product data and pass the product data over a portable data collection network). Moreover, and as was discussed above, one skilled in the art would not be motivated to combine *Ekelund* and *Tsukamoto* (cell phone technology) with *Gollnick* (data terminal technology), as evidenced by the long felt need an efficient communications scheme for workers who use portable data terminals, yet a clear

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absence of such devices in the market (despite the well known cellular communications and portable data terminal art). Further, *Gollnick* teaches away from two-way communications over a network as evidenced by the clear omission of two way voice communications (which can require significant bandwidth), despite disclosing voice mail capability (which requires substantially less bandwidth). Thus, one would not be motivated to combine *Ekelund*, *Tsukamoto* and *Gollnick*.

Accordingly, withdrawal of the rejection of claim 26 is respectfully requested.

f. Claims 30, 31, 33 and 34

Claims 30, 31, 33 and 34 stand rejected under 35 USC 103(a) as being unpatentable over *Tsukamoto* and *Ekelund* in view of *Amin* (US 6,006,087). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Claims 30, 31, 33 and 34 depend from claim 23. As discussed above, claim 23 recites a portable data terminal that includes a data reader. *Amin*, like *Tsukamoto* and *Ekelund*, has not been found to teach or suggest a data reader. Thus, the cited art does not teach or suggest all the features of claim 23.

Since claims 30, 31, 33 and 34 depend from claim 23, they can be distinguished from the cited art for at least the same reasons.

Accordingly, withdrawal of the rejection is respectfully requested.

g. Claim 25

Claim 25 stands rejected under 35 USC §103(a) *Tsukamoto*, *Ekelund* in view of *Kim* (US 6,505,040). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Claim 25 depends from claim 23. As discussed above, claim 23 recites a portable data terminal that includes a data reader. *Kim*, like *Tsukamoto* and *Ekelund* has not been found to teach or suggest a data reader. Thus, the cited art does not teach or suggest all the features of claim 23.

Since claim 25 depends from claim 23, it can be distinguished from the cited art for at least the same reasons.

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Accordingly, withdrawal of the rejection of claim 25 is respectfully requested.

h. Claim 28

Claim 28 stands rejected under 35 USC §103(a) *Tsukamoto, Ekelund* in view of *Ghisler* (US 5,539,807). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Tsukamoto and *Ekelund* each relate to cellular phone technology.

Ghisler is related to a billing method that enables a subscriber to use another phone, but have the bills associated with using the phone channeled to the subscriber's account. Thus, *Ghisler*, like the above references, also is related to a telephone system.

As discussed above, one skilled in the art attempting to address the problems solved in the invention of claim 23 would not be motivated to use cellular phone art, as it operates on substantially different networks that are optimized for different applications.

Accordingly, withdrawal of the rejection of claim 28 is respectfully requested.

IV. CONCLUSION

Accordingly, claims 8-16, 19-26, 28 and 30-39 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

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In the event any fee or additional fee is due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (under the above Docket Number). In the event an extension of time is needed to make the filing of this paper timely and no separate petition is attached, please consider this a petition for the requisite extension and charge the fee to our Deposit Account No. 18-0988 (under the above Docket Number).

Respectfully submitted,

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